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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Lal *et al.*

Application No. 09/763,397

Filed: February 16, 2001

For: RECOMBINANT MULTIVALENT MALARIAL  
VACCINE AGAINST PLASMODIUM  
FALCIPARUM

Examiner: V. Ford

Date: November 6, 2001



CERTIFICATE OF MAILING

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**ELECTION AND RESPONSE TO RESTRICTION**

This is in response to the Office action dated October 9, 2001. A one month period for response was set, making a reply due by November 9, 2001.

Claims 1-12 of this §371 National Stage application were indicated as being subject to a restriction requirement. In particular, the Examiner designated claims 1-6 and 10 as Group I, claims 7-8 as Group II, claim 9 as Group III, claim 11 as Group IV, and claim 12 as Group V. Applicants respectfully traverse the restriction requirement. Applicants believe that Group I and Group II should be examined together, and therefore request reconsideration of the restriction requirement.

Groups I and II are linked to form a single general inventive concept. 37 C.F.R. § 1.475 requires unity of invention; unity of invention is present when a group of inventions are "so linked as to form a single general inventive concept." [See 37 C.F.R. § 1.475(a).] "A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature." [MPEP § 1893.03(d). See also 37 C.F.R. § 1.475(a).]

As an example of situation where unity of invention is present, the MPEP states, "For example, a corresponding technical feature is exemplified by a key defined by certain claimed structural characteristics which correspond to the claimed features of a lock to be used with the

claimed key.” [See MPEP § 1893.03(d).] Thus, although a key and a lock are not the same, unity of invention between a key and a lock is present where certain characteristics of the key correspond to claimed features of the lock.

Similarly, unity of invention exists among Groups I and II in the present application. While claims 7 and 8 are directed to an isolated nucleic acid rather than a protein, the isolated nucleic acid of claim 7 (from which claim 8 depends) encodes the protein of claim 1. Thus, the single general inventive concept common to Groups I and II is the recombinant protein recited in claim 1. Moreover, the protein of claim 1 is neither disclosed nor rendered obvious by the prior art and thus constitutes a corresponding special technical feature, which is sufficient for the fulfillment of the unity of invention requirement. [See 37 C.F.R. § 1.475(a); MPEP § 1893.03(d).]

Applicants request that Groups I and II be examined together and that the requirement for restriction between Groups I and II be withdrawn. However, in the event the restriction requirement is maintained, Applicants provisionally elect Group I.

Respectfully submitted,

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